

### REMARKS

In response to the Office Action mailed February 9, 2005, Applicants respectfully request reconsideration. Claims 1-61 were previously pending in this application and claims 1, 29, 45, and 52 are amended herein. The application as presented is believed to be in condition for allowance.

Initially, Applicants thank Examiner Mirza for the courtesies extended in granting and conducting a telephone interview on May 2, 2005. The substance of the interview is summarized herein.

The Office Action rejects claims 1-61 under 35 U.S.C. §103(a) as purportedly being obvious over Staheli (5,537,533) in view of Miskowiec (5,915,095). Applicants respectfully traverse this rejection for the reasons stated below.

The Office Action asserts that Staheli discloses, “a method, comprising acts of: detecting a decrease in performance of a first host computer, wherein the first computer provides computational resources to perform a task.” *See* Office Action, ¶2, page 2. Applicants respectfully disagree. During the telephone interview, Applicants pointed out that Staheli discloses manually bringing a remote replacement server online in case of failure of the primary server. *See* Staheli, Col. 5, lines 36-45. Staheli discloses that the replacement server and the primary server are never online at the same time, as at most, one instance of the network operating system runs at any time, even though each server has a copy of the operating system. *See* Staheli, Col. 5, lines 39-40.

Applicants pointed out during the telephone interview that Staheli relates to the complete failure of a computer, whereas claim 1, prior to the amendment made herein, recited, “detecting a decrease in performance of a first host computer” and “automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting, so that the first and second host computers simultaneously provide computational resources to perform the task.” Staheli does not disclose detecting a decrease in performance in a server that continues to operate and the configuring of a second server to simultaneously provide resources to perform a task, but rather relates to preparing for and

responding to a complete failure of a server and manually bringing a second server online to replace the failed server, such that the operation of the two servers is mutually exclusive.

During the interview, the Examiner questioned whether the phrase, “detecting a decrease in performance of the first host computer” in claim 1 was broad enough to encompass detecting a failure of the host computer. Applicants pointed out that a complete failure could not be considered a “decrease in performance” as recited in claim 1 because claim 1 requires that the first and second host computers simultaneously provide computational resources to perform the task. The failure of the first host computer and its replacement by the second host computer does not result in the two simultaneously providing computational resources to perform the task.

Applicants have made clear in the claims and in the prosecution history that a “decrease in performance” as used in the claims does not include a failure. For example, Applicants have presented this argument in at least one prior telephone interview and at least one previously submitted response (*See, e.g.*, Applicants Response mailed March 2, 2005, pages 16-17). Nevertheless, to make absolutely clear that the decrease in performance does not include a complete failure of the computer of the type described in *Staheli*, Applicants have amended claim 1 to recite, “detecting a decrease in performance of a first host computer that results from the first host computer continuing to function but at a decreased performance level, wherein the first computer provides computational resources to perform a task.”

With respect to independent claims 29, 45, and 52, each of these claims previously recited that the first and second host computers simultaneously provide computational resources to perform the task. As stated above, the teaching in *Staheli* of bringing a replacement server online when a primary server has failed does not result in the two servers simultaneously providing computational resources to perform the task. Thus, the decrease in performance recited in these claims is clearly not a complete failure of the host computer. Nevertheless, to further clarify this point, Applicants have amended these claims to recite that the decrease in performance, “results from the first host computer continuing to function but at a decreased performance level.”

During the telephone interview, the Examiner indicated that if it were made clear that a decrease in performance does not include a failure of the type described in *Staheli*, then he

believed the claims would patentably distinguish over the combination of Staheli and Miskowiec. Understandably, the Examiner reserved final judgment on whether the claims would be in condition for allowance until after he had reviewed this response and the amendments made herein, but indicated that he would contact Applicants' representative if he felt that this Amendment did not place the application in condition for allowance.

In addition to failing to disclose detecting a "decrease in performance," Applicants respectfully point out that neither Staheli nor Miskowiec discloses or suggests, "automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting." The Office Action concedes that Staheli does not disclose this limitation and assumedly relies on Miskowiec to teach this feature. However, Applicants respectfully point out that the Office Action does not point to any disclosure of this feature in Miskowiec. The Office Action discusses Miskowiec generally, asserting that Miskowiec discloses an apparatus that relates to balancing a plurality of received processing requests among a plurality of servers, which may each run separate instances of the same application, and cites column 2, lines 52-61 of Miskowiec in support of this assertion. However, the cited portion of Miskowiec does not relate to automatic configuration of servers. Specifically, the cited portion of Miskowiec states:

[a]n exemplary apparatus in accordance with the principles of the present invention concerns balancing a plurality of received processing requests among a plurality of servers. The processing requests are received from one or more network nodes. The apparatus includes a plurality of communication ports, a storage means, and a control circuit. A subset of the communication ports are in operative communication with at least a first server, a second server and a first network node. At least each of the first and the second servers are operative to run a common application.

Miskowiec, column 2, lines 52-61.

This paragraph does not disclose the automatic configuration of a server, neither in response to detecting a decrease in performance of another server, nor for any other purpose. Rather, this paragraph relates to balancing a plurality of processing requests among a set of previously-configured servers. There is no disclosure in Miskowiec of the automatic

configuration of a server for any purpose. Thus, neither Staheli nor Miskowiec discloses or suggests, "automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting," as recited in claim 1.

Lastly, the Office Action asserts that one skilled in the art would have been motivated to combine Staheli and Miskowiec to, "have incorporated the automatically configuring a second host computer to provide additional computational resources for the first host computer in response to the act of detecting as taught by Miskowiec in the method of Staheli to substantially minimize a user's involvement in selecting a server to run a particular application with as prompt a processing time as is then available."

Applicants respectfully disagree that one of skill in the art would have been motivated by Miskowiec to modify Staheli in any respect. However, even if one were to combine Staheli and Miskowiec, the combination would not have resulted in a system that involves automatically configuring a second host computer to provide additional resources for the first host computer in response to the act of detecting a decrease in performance of the first host computer, as neither Staheli nor Miskowiec discloses or suggests automatic configuration of computers.

For the foregoing reasons, claims 1-61 patentably distinguish over Staheli and Miskowiec, whether taken alone or in combination. Accordingly, it is respectfully requested that the rejection of claims 1-61 under 35 U.S.C. §103(a) be withdrawn.

Serial No. 09/533,409 .  
Conf. No.: 2145 .

- 20 -

Art Unit: 2141

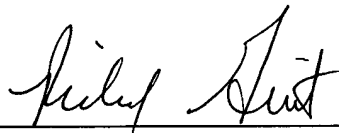
**CONCLUSION**

A Notice of Allowance is respectfully requested. The Examiner is requested to call the undersigned at the telephone number listed below if this communication does not place the case in condition for allowance.

If this response is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this response, including an extension fee, that is not covered by an enclosed check, please charge any deficiency to Deposit Account No. 23/2825.

Respectfully submitted,

*Yao Wang et al., Applicants*

By:   
Richard F. Giunta, Reg. No. 36,149  
WOLF, GREENFIELD & SACKS, P.C.  
600 Atlantic Avenue  
Boston, MA 02210-2211  
Tel. no. (617) 720-3500  
Attorney for Applicant(s)

Attorney's Docket No.: E0295.70106US00  
Date: May 5, 2005